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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/060,690	01/30/2002	Robert E. Kolb	56311US007	7025
32692	7590	03/15/2004	EXAMINER	
3M INNOVATIVE PROPERTIES COMPANY			LIPMAN, BERNARD	
PO BOX 33427			ART UNIT	PAPER NUMBER
ST. PAUL, MN 55133-3427			1713	

DATE MAILED: 03/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/060,690

Applicant(s)

KOLB ET AL.

Examiner

Bernard Lipman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) 20,21,23-28,32-35 and 37-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19,22,29-31,36 and 42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/6/02 & 7/5/02</u> . | 6) <input type="checkbox"/> Other: _____ |

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1. Applicants' election with traverse of Group I in papers filed January 5, 2004 is acknowledged. The traversal is on the ground(s) that the different inventions have overlapping searches and a search for one would of necessity entail searching the others. This is not found persuasive because the searches are not, in fact, co-extensive, and issues of patentability are materially different for the various groups. Applicants can overcome a restriction requirement by stipulating that the differences between the groups are obvious one from the other, but applicants have chosen not to do so.

The requirement is still deemed proper and is therefore made FINAL.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless ---
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth

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in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-15, 16, 17-19, 22, 29-31, 36 and 42 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Jing et al., U.S. Patent 5,728,773 or Fukushima, U.S. Patent 5,451,625 or Guerra et al., U.S. Patent 5,384,374. Each of the patents cited teaches the use of fluoroelastomer compositions containing components which, when mixed together and reacted, would give the reactants required by applicants' claimed compositions. The compositions stipulate that the B catalyst can be made in situ and the catalyst is a reactant of either diol or diacid compositions along with ammonium or phosphonium salts. Each of the reference stipulates that their compositions contain these components, which, in situ, would give applicants' claimed catalysts absent evidence of structural difference. The components of the references are deemed cross-linking agents and co-catalysts, and react together in the compositions. There is, therefore, reasonable presumption that they would react in the proper way to give the structures as required by applicants' claims absent

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evidence to the contrary, In re Fitzgerald et al., 205 USPQ 594.

The claims, as understood, are, therefore, properly rejected under 35 U.S.C. § 102 or 103.

3. Claims 1-15, 16 (with carbon filler only), 17-19, 22, 29-31, 36 and 42 are rejected under 35 U.S.C. § 112 as being broader than one of ordinary skill in the art is enabled from the disclosure to practice the invention. The use of catalytic entities for compositions is notoriously unpredictable. Applicants have claimed a broad spectrum of reactive polymers with, and in conjunction with, a broad range of "catalysts". Nowhere is one of ordinary skill in the art enabled from the disclosure to predict usability for the multitude of combinations of polymers and catalysts as encompassed by the claims. Even the claims stipulate specific structures, they are not commensurate in scope to the combination of specific entities enabled by the disclosure. One of ordinary skill in the art would require undue experimentation to determine which of the multitude of catalysts encompassed by the structures as claimed, especially in view of the terminologies of "acid derivative" and "nitrogen-containing cure site monomer", would result in usable compositions. The claims as drawn are, therefore, broader than one of ordinary skill in the art is enabled from the disclosure to practice the invention without undue experimentation.

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4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bernard Lipman whose telephone number is (571) 272-1105. The examiner can normally be reached on Mondays through Fridays from 7 A.M. to 4:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on (571) 272-1114.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-0994.


Bernard Lipman
Primary Examiner
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BL:cdc
March 4, 2004